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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Dunn et al.	:	Almatrahi, Faris S.
	:	
Serial No.: 10/727,016	:	Group Art Unit: 3627
	:	
Filing Date: December 3, 2003	:	
	:	IBM Corporation
Title: METHOD FOR	:	Dept. T81/Bldg. 503
TRANSFER OF ORDERS FROM	:	P.O. Box 12195
AN ORDER MANAGEMENT	:	3039 Cornwallis Road
SYSTEM TO AN ELECTRONIC	:	Research Triangle Park, NC 27709
MARKETPLACE	:	

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I.   REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation, which is the assignee of the entire right, title and interest in the above-identified patent application.

II.   RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III.   STATUS OF CLAIMS

Claims 1-28 are pending in the Application.   Claims 1-18 and 28 are withdrawn. Claims 19-27 stand rejected. Claims 19-27 are appealed.

IV.   STATUS OF AMENDMENTS

Appellants submitted an amendment on October 26, 2008 following receipt of the final office action with a mailing date of July 25, 2008. In the after-final amendment, Appellants amended claims 21 and 22 to remove the "means for" language in claims 21 and 22 to address the Examiner's rejections of claims 21-23 under 35 U.S.C. §101. The Examiner indicated in an Advisory Action (November 5, 2008) that the amendments would not be entered because they allegedly do not reduce or simplify the issues for appeal. However, on December 3, 2008, the Examiner indicated that he would enter the amendments to claims 21 and 22 and withdraw the rejections under 35 U.S.C. §101.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 19:

In one embodiment of the present invention, a computer-implemented method for filling orders for items using an order management system, the method comprises the step of associating one or more items in an order with one of a set of fulfillment centre objects of an order management system for representing one or more fulfillment centres and one or more electronic marketplaces using a release to fulfillment object. Specification, page 12, lines 1-6; Specification, page 15, lines 3-9; Specification, page 16, lines 14-16; Figure 2, step 48. The method further comprises sending fulfillment instructions relating to one or more items associated with one of a first subset of fulfillment centre objects to a corresponding fulfillment centre, where the first subset of the fulfillment centre objects being defined for representing corresponding fulfillment centres. Specification, page 13, lines 3-11. Additionally, the method comprises sending ordering information relating to one or more items associated with one of a second subset of fulfillment centre objects to a corresponding electronic marketplace, where the second subset of the fulfillment centre objects being defined for representing corresponding electronic marketplaces. Specification, page 16, line 21 – page 17, line 1.

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

     A.   Claims 19-27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hirth et al. (U.S. Patent Application Publication No. 2003/0171962) (hereinafter "Hirth").

VII.   ARGUMENT

     A.   Claims 19-27 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Hirth.

     The Examiner has rejected claims 19-27 under 35 U.S.C. §103(a) as being unpatentable over Hirth. Appellants respectfully traverse these rejections for at least the reasons stated below.

          1.   Claim 19 is patentable over Hirth.

     The Examiner cites the Abstract and paragraphs [0038-0041 and 0074] of Hirth as teaching "associating one or more items in an order with one of a set of fulfillment centre objects of an order management system for representing one or more fulfillment centres and one or more electronic marketplaces using a release to fulfillment object" as recited in claim 19. Office Action (7/25/2008), page 3. Appellants respectfully traverse.

     Hirth instead teaches receiving the order; breaking the order into one or more work packages; determining whether the order should be filled entirely within the organization of the recipient of the order and/or by using external organizations entirely or in part; and assigning the work packages to respective partners. [0038]. Further, Hirth teaches that after the order has been received, the fulfillment coordination engine splits the order into one or more work packages based on a first set of rules or parameters. [0040]. Additionally, Hirth teaches that the work packages can be based on, for example, rules such as location of the production of the product, location of the parts or goods used to make the produce, and steps in the production process relating to different operations. [0040]. Furthermore, Hirth teaches that after

the order has been split into work packages, the fulfillment coordination engine assigns the work packages to partners based on a second set of rules or parameters. [0042]. Further, Hirth teaches that the original logistic request (for example, customer order, return goods notification) will be split or distributed into different logistic activities. [0074]. Furthermore, Hirth teaches that all of the logistics activities belonging to one specific request form a logistics object. [0074]. Additionally, Hirth teaches that comparable activities from different logistics objects can be consolidated into one or more common logistics orders (e.g., arbitrary transport, monitoring of value-added services). [0074].

Hence, Hirth teaches determining whether the order should be filled entirely within the organization of the recipient of the order and/or by using external organizations entirely or in part. Further, Hirth teaches that the original logistic request (for example, customer order, return goods notification) will be split or distributed into different logistic activities and that all of the logistics activities belonging to one specific request form a logistics object.

There is no language in the cited passages that teaches associating one or more items in an order with one of a set of fulfillment centre objects of an order management system for representing one or more fulfillment centres and one or more electronic marketplaces using a release to fulfillment object. Instead, the cited passages teach that the logistics activities belonging to one specific request form a logistics object. There is no language in the cited passages that teaches that the logistic object represents a fulfillment centre and an electronic marketplace. A fulfillment centre is a physical location where inventory for a vendor is located. See Appellants' Specification, page 10, lines 22-23. Further, an electronic marketplace is an automated marketplace in which suppliers may bid to fill orders placed using a trading mechanism. See Appellants' Specification, page 4, lines 19-21. Neither is there any language in the cited passages that teaches associating one or more items in an order with one of a set of fulfillment centre objects of an order management system for representing one or more fulfillment centres and one or more electronic

marketplaces <u>using a release to fulfillment object</u>. The only "object" discussed in Hirth refers to the logistics object which the Examiner cites as teaching the claimed fulfillment center objects. Hence, using the Examiner's interpretation, Hirth does not teach at least using a release to fulfillment object as discussed on at least page 12, lines 21-24 of Appellants' Specification.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 19, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Additionally, the Examiner cites paragraphs [0041-0043, 0086, 0136-0137 and 0146] of Hirth as teaching "sending ordering information relating to one or more items associated with one of a second subset of fulfillment centre objects to a corresponding electronic marketplace" as recited in claim 19.   Office Action (7/25/2008), pages 3-4. Appellants respectfully traverse.

Hirth instead teaches that after the order has been split into work packages, the fulfillment coordination engine assigns the work packages to partners based on a second set of rules or parameters (step 115). [0041]. Hirth further teaches that these rules can be based on a company policy that sets a priority for partners, for example, use partner A in preference to partner B and use partner B in preference to partner C. [0041]. Additionally, Hirth teaches that after the order has been split into work packages, the fulfillment coordination engine assigns the work packages to partners based on a second set of rules or parameters. [0042].   Hirth further teaches that examples of partners can be selected include customer, supplier, production plant, distribution center and service provider. [0086]. In addition, Hirth teaches receiving orders form multiple order taking systems. [0146].

Hence, Hirth teaches after the order has been split into work packages, the fulfillment coordination engine assigns the work packages to partners based on a second set of rules or parameters. Hirth further teaches that partners may be a distribution center.

There is no language in the cited passages that teaches sending ordering information relating to one or more items associated with one of a second subset of fulfillment centre objects to a corresponding electronic marketplace. While Hirth teaches a distribution center, Hirth refers to the distribution center as a warehouse. See paragraph [0054] of Hirth. A warehouse is a physical structure or room for storing merchandise. (See definition from http://www.merriam-webster.com/dictionary/warehouse). However, an electronic marketplace is an automated marketplace in which suppliers may bid to fill orders placed using a trading mechanism supported by an electronic marketplace (for example, by use of shopping carts, requests for proposals, auctions, reverse auctions, or requests for quotations). See, for example, page 14, lines 19-23 of Appellants' Specification.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 19, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Further, the Examiner asserts that "wherein the second subset of the fulfillment centre objects being defined for representing corresponding electronic marketplaces" as recited in claim 19 is descriptive material. Office Action (7/25/2008), page 4. The Examiner cites *In re Ngai*, 70 U.S.P.Q.2d 1862 (Fed. Cir. 2004); *In re Gulack*, 217 U.S.P.Q.401, 404 (Fed. Cir. 1983); and *In re Lowry*, 32 U.S.P.Q.2d 1031 (Fed. Cir. 1994) to support the Examiner's contention that the above-cited claim limitation is non-functional descriptive material. *Id.*

The cases that the Examiner cites are found in M.P.E.P. §2106.01. According to M.P.E.P. §2106.01, *In re Gulack* and *In re Lowrey* are directed to the situation in which the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine. M.P.E.P. §2106. That is not the case here. As pointed out, there are numerous limitations in the claimed inventions not taught or suggested in Hirth. Consequently, the Examiner's reliance of *In re Gulack* and *In re Lowrey* is improper.

Further, M.P.E.P. §2106.01 defines "non-functional descriptive material" as including but not limited to <u>music, literary works, and a compilation or mere arrangement of data</u>. M.P.E.P. §2106.01 continues by stating that when non-functional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. M.P.E.P. §2106.01 further states that merely claiming non-functional descriptive material, i.e., <u>abstract ideas</u>, stored on a computer-readable medium, in a computer, does not make it statutory. Further, M.P.E.P. §2106.01 states that non-statutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

The above-recited limitation that the Examiner claims to be non-functional descriptive material is <u>not related to music, literary works, a compilation or mere arrangement of data</u>. <u>Neither is this claim limitation an abstract idea</u>. <u>Neither is this claim limitation protectable under copyright law</u>. This limitation is not non-functional descriptive material.

The above-cited claim limitation is directed to further defining the second subset of the fulfillment centre objects. These are defined for representing corresponding electronic marketplaces. This is not an abstract idea or related to music, a literary work, a compilation or a mere arrangement of data.

As a result of the above, the above-cited claim limitation is not non-functional descriptive material as asserted by the Examiner. The Examiner must not ignore this claim limitation.

2.   <u>Claims 20-27 are patentable over Hirth for at least the reasons that claim 19 is patentable over Hirth.</u>

Claims 20-27 each recite combinations of features of independent claim 19, and hence claims 20-27 are patentable over Hirth for at least the above-stated reasons that claim 19 is patentable over Hirth.

3.   Claim 20 is patentable over Hirth.

The Examiner cites paragraphs [0043, 0049 and 0076] of Hirth as teaching "in which a release to fulfillment object associated with a selected one of the fulfillment centre objects in the second subset comprise data representations for tracking orders in the electronic marketplace corresponding to the selected fulfillment centre object" as recited in claim 20. Office Action (7/25/2008), pages 4-5. Appellants respectfully traverse.

Hirth instead teaches that the work tasks also can include the internal and/or external partners supplying the goods to the company. [0043]. Hirth further teaches that when stocks used in the fulfillment process are distributed over different physical locations, which can be handled by internal or external partners, the fulfillment coordination engine determines these partners and provides the information important to do the actual work on time. [0049]. Hirth additionally teaches that the fulfillment coordination engine splits the sales order into one or more work packages (step 110) and assigns the work packages, which includes the information necessary to perform the actual work on time, to the partners (step 115). [0049]. Additionally, Hirth teaches that the necessary operations to fulfill the request or order are communicated to corresponding partners using standard interfaces and formats. [0076].

Hence, Hirth teaches work tasks can include the internal and external partners supplying the goods to the company. Further, Hirth teaches splitting the sales order into one or more work packages and assigning the work packages, which includes the information necessary to perform the actual work on time, to the partners.

There is no language in the cited passages that teaches a release to fulfillment object associated with a selected one of the fulfillment centre objects in the second subset. There is no language in the cited passages that teaches the concept of an object or a release to fulfillment object associated with a selected one of the fulfillment centre objects in the second subset, where the second subset being defined for representing corresponding electronic marketplaces. Further, there is no language

in the cited passages that teaches a release to fulfillment object associated with a selected one of the fulfillment centre objects in the second subset that <u>comprises data representations for tracking orders</u>. Instead, the cited passages teaches splitting a sales order into one or more work packages, which includes information necessary to perform the actual work on time. There is no disclosure of the concept of having data representations for tracking orders. Neither is there any language in the cited passages that teaches a release to fulfillment object associated with a selected one of the fulfillment centre objects in the second subset that comprises data representations for <u>tracking orders in the electronic marketplace</u>. Neither is there any language in the cited passages that teaches a release to fulfillment object associated with a selected one of the fulfillment centre objects in the second subset that comprises data representations for tracking orders in the electronic marketplace <u>corresponding to the selected fulfillment centre object</u>.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 20, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

4.   <u>Claim 21 is patentable over Hirth.</u>

The Examiner cites paragraph [0041] of Hirth as teaching "in which each fulfillment centre objects represents one or more inventory and fulfillment centre priority" as recited in claim 21. Office Action (7/25/2008), page 5. Appellants respectfully traverse.

As stated above, Hirth instead teaches a fulfillment coordination engine splitting an order into one or more work packages based on a first set of rules or parameters.

There is no language in the cited passage that teaches that <u>each fulfillment centre object represents one or more inventory and fulfillment centre priority</u>. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 21, since the Examiner is relying upon incorrect, factual predicates in

support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

        5.   Claim 22 is patentable over Hirth.

     The Examiner cites paragraphs [0041 and 0083] of Hirth as teaching "in which the representing of the one or more inventory and fulfillment centre priority in the second subset of fulfillment centre objects represents one or more of a null inventory and a low fulfillment centre priority" as recited in claim 22. Office Action (7/25/2008), page 5. Appellants respectfully traverse.

     As stated above, Hirth instead teaches a fulfillment coordination engine splitting an order into one or more work packages based on a first set of rules or parameters. [0041]. Hirth further teaches that the available-to-promise (ATP) service is used to check the availability of an order quantity of a product for supplying the product by a certain date. [0083]. Hirth additionally teaches that to meet the date and quantity requirements, the ATP service is able to adjust various parameters of a logistics process, including changing the steps of a logistics process, changing the partners/locations, changing the schedules, and changing the products. [0083].

     Hence, Hirth teaches splitting an order into one or more work packages based on a first set of rules or parameters. Hirth further teaches checking the availability of an order quantity of a product for supplying the product by a certain date.

     There is no language in the cited passages that teaches that representing one or more inventory and fulfillment centre priority <u>in the second subset of fulfillment centre objects</u> <u>represents one or more of a null inventory and a low fulfillment centre</u> <u>priority</u>. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 22, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

        6.   Claim 23 is patentable over Hirth.

     The Examiner cites paragraphs [0041 and 0083-0085] of Hirth as teaching "pre-selecting items for association with one of the set of fulfillment centre objects

based on one or more inventory and fulfillment centre priority" as recited in claim 23. Office Action (7/25/2008), page 5. Appellants respectfully traverse.

As stated above, Hirth instead teaches a fulfillment coordination engine splitting an order into one or more work packages based on a first set of rules or parameters. [0041]. Hirth further teaches checking the availability of an order quantity of a product for supplying the product by a certain date. [0083]. Additionally, Hirth teaches a scheduling program that is a service that determines the schedules for every step of a logistics process, such as transport schedules, shipping schedules, etc. [0084]. Further, Hirth teaches that the product selection or substitution service selects the correct product for a logistics process according to batches, serial numbers, shelf life expiration date, and stock determination. [0085].

There is no language in the cited passages that teaches pre-selecting items for association with one of the set of fulfillment centre objects. Instead, Hirth teaches checking the availability of an order quantity of a product as well as discloses substituting a customer's product selection. Neither is there any language in the cited passages that teaches pre-selecting items for association with one of the set of fulfillment centre objects based on one or more inventory and fulfillment centre priority.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 23, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

> 7.   Claim 24 is patentable over Hirth.

The Examiner cites Figure 5 and paragraph [0088] of Hirth as teaching "in which the order management system comprises an administrator interface, and the method further comprises the step of an administrator using the administrator interface to confirm or over-ride the pre-selection of items for association with one of the set of fulfillment centre objects" as recited in claim 24. Office Action (7/25/2008), page 5. Appellants respectfully traverse.

Hirth instead teaches a service that adds logistics master data to the incoming orders if that type of data is not already present in the order and provides protocol data for the monitoring of the complete process. [0088].

There is no language in the cited passage that teaches an administrator using the administrator interface to confirm or over-ride the pre-selection of items for association with one of the set of fulfillment centre objects. Instead, Hirth teaches adding logistics master data to the incoming orders if that type of data is not already present in the order. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 24, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

> 8.   Claim 25 is patentable over Hirth.

The Examiner cites paragraphs [0010 and 0053-0055] of Hirth as teaching "step of grouping items and in which the step of sending ordering information further comprises maintaining the grouping of the items when information corresponding to the grouped items is sent to the corresponding electronic marketplace" as recited in claim 25. Office Action (7/25/2008), pages 5-6. Appellants respectfully traverse.

Hirth instead teaches that goods can be consolidated by obtaining goods from each of the partners to which a work package is assigned. [0010]. Hirth further teaches splitting an original order when different tasks and/or partners are necessary. [0053].

Hence, Hirth teaches assigning separate work packages to separate partners. Further, Hirth teaches splitting an original order when different tasks and/or partners are necessary.

There is no language in the cited passages that teaches that the step of sending ordering information further comprises maintaining the grouping of the items when information corresponding to the grouped items is sent to the corresponding

electronic marketplace. Instead, the cited passages teaches splitting an original order and assigning separate work packages to separate partners. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 25, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

VIII.   CONCLUSION

For the reasons noted above, the rejections of claims 19-27 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 19-27.

Respectfully submitted,

WINSTEAD P.C.

Attorneys for Appellants

By: _____
        Robert A. Voigt, Jr.
        Reg. No. 47,159

P.O. Box 50784
Dallas, Texas 75201
(512) 370-2832

CLAIMS APPENDIX

19.   A computer-implemented method for filling orders for items using an order management system, the method comprising the steps of:

associating one or more items in an order with one of a set of fulfillment centre objects of an order management system for representing one or more fulfillment centres and one or more electronic marketplaces using a release to fulfillment object,

sending fulfillment instructions relating to one or more items associated with one of a first subset of fulfillment centre objects to a corresponding fulfillment centre, wherein the first subset of the fulfillment centre objects being defined for representing corresponding fulfillment centres, and

sending ordering information relating to one or more items associated with one of a second subset of fulfillment centre objects to a corresponding electronic marketplace, wherein the second subset of the fulfillment centre objects being defined for representing corresponding electronic marketplaces.

20.   The method of claim 19, in which a release to fulfillment object associated with a selected one of the fulfillment centre objects in the second subset comprise data representations for tracking orders in the electronic marketplace corresponding to the selected fulfillment centre object.

21.   The method of claim 19, in which each fulfillment centre objects represents one or more inventory and fulfillment centre priority.

22.   The method of claim 21, in which the representing of the one or more inventory and fulfillment centre priority in the second subset of fulfillment centre objects represents one or more of a null inventory and a low fulfillment centre priority.

23.   The method of claim 21, further comprising the step of pre-selecting items for association with one of the set of fulfillment centre objects based on one or more inventory and fulfillment centre priority.

24.   The method of claim 23, in which the order management system comprises an administrator interface, and the method further comprises the step of an administrator using the administrator interface to confirm or over-ride the pre-selection of items for association with one of the set of fulfillment centre objects.

25.   The method of claim 19, further comprising the step of grouping items and in which the step of sending ordering information further comprises maintaining the grouping of the items when information corresponding to the grouped items is sent to the corresponding electronic marketplace.

26.   The method of claim 25 in which the step of grouping items comprises grouping the items corresponding to the order from which the items were received by the order management system.

27.   The method of claim 25 in which the step of grouping items comprises grouping the items corresponding to an aggregation of items from a single order received by the order management system.

EVIDENCE APPENDIX

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of 37 C.F.R. or of any other evidence entered by the Examiner and relied upon by Appellants in the Appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings to the current proceeding.